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Docket No.: 245112US2DIV

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 10/713,044
Applicants: Takashi IPPOSHI, et al.
Filing Date: November 17, 2003
For: SEMICONDUCTOR DEVICE FOR LIMITING
LEAKAGE CURRENT
Group Art Unit: 2811
Examiner: T. Tran

SIR:

Attached hereto for filing are the following papers:

Provisional Election of Species

Our check in the amount of _____ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 245112US2DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TAKASHI IPPOSHI, ET AL. : EXAMINER: T. TRAN
SERIAL NO: 10/713,044 :
FILED: NOVEMBER 17, 2003 : GROUP ART UNIT: 2811
FOR: SEMICONDUCTOR DEVICE FOR :
LIMITING LEAKAGE CURRENT

PROVISIONAL ELECTION OF SPECIES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species requirement dated September 23, 2004, Applicants provisionally elect with traverse Species 1 corresponding to the embodiment of Figure 29, and identify Claims 5-7, 9, 10 and 16 as readable on the provisionally elected species.

Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "the application contains claims directed to ... patentably distinct species ..." without stating any basis whatsoever in support of such a finding. This is contrary to MPEP § 816, which states:

MPEP § 816

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

MPEP § 806.04(f)

Claims to be restricted to different species must be mutually exclusive...

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, as previously pointed out, MPEP § 803 states:

MPEP § 803

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants also respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

In this particular case, since Applicants are at a loss as to the basis of the Election Requirement, in view of the fact that the Requirement does not state any analysis on how the species were decided, Applicants respectfully request that the requirement be withdrawn, or at the very least, that a new Official Action be mailed stating the basis for the Election

Requirement and remedying the deficiencies above-noted, so that Applicants can then appropriately respond on the merits of the requirement.

Respectfully submitted,

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